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PATENT GROUP 2N			MAI, HUY KIM	
JONES DAY				
NORTH POINT				
901 LAKESIDE AVENUE				
CLEVELAND, OH 44114				
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DANIEL V. POMPILIO and JASON P. ZAMER

Appeal 2015-005357
Application 13/330,779
Technology Center 2800

Before ADRIENE LEPIANE HANLON, MICHAEL P. COLAIANNI, and
CHRISTOPHER L. OGDEN, *Administrative Patent Judges*.

HANLON, *Administrative Patent Judge*.

DECISION ON REHEARING

The Appellants request rehearing of a DECISION ON APPEAL dated February 24, 2017.¹ In that Decision, we (1) reversed the 35 U.S.C. § 112, first paragraph, rejection of claims 1–6 and 8–25, based on the written description requirement; (2) affirmed the 35 U.S.C. § 112, second paragraph, rejection of claims 1–6 and 8–25; and (3) reversed the 35 U.S.C. § 102(e) rejection of claims 1–6 and 8–25 based on *Kürkure*.²

¹ Hereinafter “Decision.”

² In the Decision, we emphasized that our reversal of the § 102(e) rejection was not based on the merits of the rejection but rather was a procedural reversal predicated upon the indefiniteness of the claims. Decision 8.

A request for rehearing must state with particularity the points believed to have been misapprehended or overlooked by the Board. Arguments not raised in the briefs before the Board and evidence not previously relied upon in the briefs are not permitted in a request for rehearing except as permitted by 37 C.F.R. §§ 41.52(a)(2) through (a)(4). *See* 37 C.F.R. § 41.52(a)(1) (2016).

I.

On rehearing, the Appellants argue that the Board’s Decision “side-stepped the main issue to be decided, whether the pending claims are anticipated by Kurkure, via a claim construction determination that was not at issue in the case or briefed by Applicant or the Examiner.” Request 2.

Contrary to the Appellants’ argument, the definiteness of independent claims 1, 24, and 25 was an issue on appeal. In particular, the Examiner concluded that the claims on appeal are rendered indefinite by the phrase “the test measures a user’s cognitive ability” recited in claims 1, 24, and 25, because it is unclear on this record whether the eye test disclosed in the Appellants’ Specification measures a user’s cognitive ability. Non-Final 10. In that regard, the Appellants’ Specification fails to define the term “cognitive” or exemplify a test that measures cognitive ability. *See* Decision 7 (“the only express description of a test that measures ‘a user’s cognitive ability’ is found in the originally filed claims”). We recognize that the Specification discloses several tests, i.e., an eye test, a mouse dexterity test, and a touch screen dexterity test. However, the Specification does not disclose a relationship between any of those tests and measuring a user’s cognitive ability.

Original claim 1 recites, in relevant part, “A computer-implemented method of adaptively controlling a user experience, comprising: administering . . . a test to

record user metrics; wherein *the test measures a user's cognitive ability . . .*” Spec. 25 (emphasis added). Original claim 13, which depends from claim 1, recites “wherein the test *further includes* an eye test . . .” Spec. 27 (emphasis added). The Board held that “[b]ased on the doctrine of claim differentiation and the language of original claim 13, it is unclear whether an eye test is an example of a test that measures a user’s cognitive ability or is a test in addition to measuring a user’s cognitive ability.” Decision 7.

On rehearing, the Appellants do not direct us to any error in the Board’s factual findings or legal conclusions. Rather, the Appellants argue that

- “wherein the test further includes an eye test” in claim 13 is intended to be construed as “wherein the test comprises an eye test;”
- “wherein the test further includes a mouse dexterity test” in claim 16 is intended to be construed as “wherein the test comprises a mouse dexterity test;” and
- “wherein the test further includes a touch screen dexterity test” in claim 20 is intended to be construed as a “a touch screen dexterity test.”

Request 4.

The Appellants, however, do not direct us to any portion of the original disclosure that supports their construction of claims 13, 16, and 20.

The Appellants also submit an amendment under 37 C.F.R. § 41.31(c), with their request for rehearing, cancelling claims 13, 16, and 20. Request 3.

According to 37 C.F.R. § 41.33 (2016),

(b) Amendments filed on or after the date of filing a brief pursuant to § 41.37 may be admitted:

(1) To cancel claims, where such cancellation does not affect the scope of any other pending claim in the proceeding

(c) All other amendments filed after the date of filing an appeal pursuant to § 41.31(a)(1) through (a)(3) will not be admitted except as permitted by §§ 41.39(b)(1), 41.50(a)(2)(i), and 41.50(b)(1).

In this case, § 41.33(c) is not applicable because the amendment is not responsive to a new ground of rejection or a remand by the Board. Therefore, we turn to § 41.33(b). As explained above and in the Board's Decision, the scope of independent claims 1, 24, and 25 is unclear. The Appellants argue that the eye test, the mouse dexterity test, and the touch screen dexterity test recited in claims 13, 16, and 20, respectively, are intended to be examples of a test that measures a user's cognitive ability and the amendment cancels those claims "to *eliminate the ambiguity* perceived by the Board." Request 3 (emphasis added). Thus, the Appellants' amendment can be said to effect the scope of the claims, which is prohibited by § 41.33(b).

Moreover, regardless of whether the Appellants' amendment is entered,³ the scope of "the test measures a user's cognitive ability" is unclear because the Appellants' Specification does not define the term "cognitive" or disclose a relationship between measuring a user's cognitive ability and the disclosed eye test, mouse dexterity test, or touch screen dexterity test.

II.

The Appellants also request that "the Board reconsider its decision not to reach the § 102 rejections for equitable reasons – to relieve Applicant of another 2+ year trip through the appeal queue, where the issues are presently ripe for decision." Request 3.

³ The original claims are part of the original disclosure regardless of whether they are cancelled in the Appellants' amendment.

As explained in the Decision, “speculation and assumptions would be required to determine whether the claimed subject matter is anticipated by Kùrkure.” Decision 8. We decline to speculate whether the claim language at issue encompasses an eye test because “[i]t is the applicants’ burden to precisely define the invention, not the PTO’s.” *In re Morris*, 127 F.3d 1048, 1056 (Fed. Cir. 1997). Moreover, “[s]peculation and assumptions . . . are not proper in a prior art rejection.” Decision 8 (citing *In re Steele*, 305 F.2d 859, 862–63 (CCPA 1962)).

III.

The Appellants’ Request for Rehearing has been granted to the extent that the DECISION ON APPEAL dated February 24, 2017, has been reconsidered in light of the Appellants’ arguments. However, the Request is denied because the Decision is not modified in any respect.

REHEARING DENIED